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Ex parte Roger D. Masham

Appeal No. 671-94 from Art Unit 152.

Application for Patent filed May 24, 1984, Serial No. 613,686. Mixing Device For Particulate Material.

Board of Patent Appeals and Interferences

*1987 Pat. App. LEXIS 23; 2 U.S.P.Q.2D (BNA) 1647*

February 26, 1987, Decided

[\*1]

Before Serota, Chairman, and Pellman, Seidleck, Lovell and Steiner, Examiners-in-Chief.

**COUNSEL:**

Henry Fleischer et al. for appellants.

Henry Fleischer et al.

Xerox Corporation

Xerox Square 020

Rochester, NY 14644

Primary Examiner - Norman Morgenstern.

Examiner - Kenneth Jaconetty.

**OPINIONBY: STEINER**

**OPINION:**

Steiner, Examiner-in-Chief.

This is an appeal from the final rejection of claims 1 through 9. In an amendment submitted on June 24, 1985, claims 2 through 9 were cancelled leaving claim 1. There are no other claims remaining in the application.

Claim 1 reads as follows:

1. An apparatus for mixing flowing developer material, including:

means, defining a chamber, for receiving the flowing developer material therein; and

means for mixing the flowing developer material, said mixing means being stationary and completely submerged in the developer material.

The reference relied upon by the examiner is:  
Williams                  4,075,977                  Feb. 28, 1978

The appealed claims stand rejected under 35 U.S.C. 102(b) as anticipated by Williams. We affirm.

Structurally, the claimed apparatus comprises a chamber and stationary mixing means situated therein. The pre-ambular recitation "for mixing flowing developer [\*2] material . . ." and the additional recitation "completely submerged in the developer material" relate to the identity of the material worked upon by the claimed apparatus and the intended manner of employing the claimed apparatus.

Williams discloses an apparatus satisfying the structural requirements of that claimed; i.e., the disclosed apparatus comprises a chamber and a stationary mixing means situated therein. The disclosed apparatus also enjoys the same utility as that claimed; i.e., for mixing flowing developer material. As the only difference between the claimed invention and the apparatus disclosed by Williams, appellant argues that the mixing means of the claimed apparatus is "completely submerged in the developer material"; whereas, in Williams' apparatus, the mixing means is depicted "as only being partially submerged in the developer material" (page 4 of the brief, first full paragraph).

The apparatus disclosed by Williams is employed to mix developer material. Accordingly, the disclosed apparatus satisfies the recitations in claim 1 with respect to the identity of the material intended to be worked upon by the claimed apparatus and the general manner in [\*3] which the claimed apparatus is intended to be employed. At any rate, a recitation with respect to the material intended to be worked upon by a claimed apparatus does not impose any structural limitations upon the claimed apparatus which differentiates it from a prior art apparatus satisfying the structural limitations of that claimed. See *In re Rishoi*, 197 F.2d 342, 94 USPQ 71 (CCPA 1952) and *In re Young*, 75 F.2d 996, 25 USPQ 69 (CCPA 1935). Similarly, a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the structural limitations of that claimed. See *In re Yanush*, 477 F.2d 958, 177 USPQ 705 (CCPA 1973), *In re Finsterwalder*, 436 F.2d 1028, 168 USPQ 530 (CCPA 1971), *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 136 USPQ 458 (CCPA 1963). In this respect, the examiner has factually determined that Williams' mixing device 40 is capable of being totally submerged in the developer material, since gate member 46 is capable of retaining a supply of developer above the top surface of mixing [\*4] device 40. Appellant has not challenged the examiner's factual determination, which determination appears to be based upon sound technical reasoning.

In *In re Pearson*, 494 F.2d 1399, 181 USPQ 641 (CCPA 1974), it was held that a recitation of intended use in a claim directed to a composition does not impose any limitations which differentiates the claimed composition from those which are known in the art. By analogy, the apparatus disclosed by Williams does not undergo a metamorphosis to a new apparatus merely by affixing instructions thereto indicating that a sufficient amount of developer material may be poured into the apparatus to completely submerge the stationary mixing means.

Based upon the foregoing, we agree with the examiner's position that the recitation "completely submerged in the developer material" does not impose any structural limitations upon the claimed apparatus which differentiates it from that disclosed by Williams. We, therefore, agree with the examiner's determination that Williams' apparatus anticipates that claimed within the meaning of 35 U.S.C. 102(b).

AFFIRMED

**Legal Topics:**

For related research and practice materials, see the following legal topics:  
Patent LawInequitable ConductEffect, Materiality & ScienterGeneral OverviewPatent LawU.S. Patent & Trademark Office ProceedingsExaminationsGeneral Overview

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